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Date: July 28, 2006

Brooke French  
Brooke French

In re application of: **Ford**

Confirmation No.: **5498**

U.S. Application Number: **09/779,390**

Art Unit: **2155**

Filing Date: **February 7, 2001**

Examiner: **Wang, Liang Che A.**

Our Reference Number: **10007261-1 (50819-1010)**

Title: **System and Method for Accessing Software Components in a Distributed Network Environment**

**Response to Notice of Non-Compliant Appeal Brief  
Substitute Appeal Brief**

**Total Pages Transmitted (including cover sheet) - 32**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	
	)	
Ford	)	Group Art Unit: 2155
	)	
Serial No.: 09/779,390	)	Examiner: Wang, Liang Che A.
	)	
Filed: February 7, 2001	)	Confirmation No. 5498
	)	
For: System and Method for Accessing Software	)	
Components on a Distributed Network	)	
Environment	)	HP Docket No.: 10007261-1
	)	TKHR Docket: 50819-1010

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

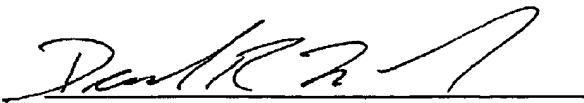
Sir:

On July 24, 2006, the Patent Office mailed a Notification of Non-Compliant Appeal Brief, in the above-referenced patent application. This notification alleged that the Appeal Brief was non-compliant because Section V fails to contain a concise explanation of the subject matter of independent claim 20, and likewise that in second VI, claim 20 was missing. Finally, the Notification alleged that Section X was misnumbered (having two Section LXs).

Applicant submits the accompanying Substitute Appeal Brief, which addresses and overcomes the alleged deficiencies.

No fee is believed to be due in connection with this submission. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:   
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	
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**SUBSTITUTE APPEAL BRIEF UNDER 37 C.F.R. §1.192**

Mail Stop Appeal Brief - Patents  
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner Wang, Liang Che A., Group Art Unit 2155, mailed February 8, 2006, rejecting all claims 1-21 in the present application and making the rejection FINAL.

**I. REAL PARTY IN INTEREST**

The real party in interest of the instant application is Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

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## **II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **III. STATUS OF THE CLAIMS**

Claim 1-21 are pending in this application. As all claims 1-21 were rejected by the FINAL Office Action, all pending claims are the subject of this appeal. The Office Action rejected all claims 1-21 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al (hereafter '896 patent or Utsumi) and U.S. Patent 5,511,208 to Boyles (hereafter '208 patent or Boyles).

## **IV. STATUS OF AMENDMENTS**

No amendments have been made or requested since the mailing of the FINAL Office Action and all amendments submitted prior to the FINAL action have been entered. A copy of the current claims is attached hereto as Exhibit A.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Embodiments of the claimed subject matter are illustrated in FIGs. 2, 3A and 3B. The embodiments illustrated in FIGs. 3A and 3B are discussed in the specification at least at page 11, line 19 through page 19, line 16.

As embodied in claim 1, in a distributed computer networked system having at least one service consumer (*see e.g.*, ref. num. 214 and related description) and at least one service provider (*see e.g.*, ref. num. 212 and related description), a method accesses a remote software component by a service consumer (*see e.g.*, ref. num. 214 and related description) comprising:

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generating (*see e.g.*, ref. num. 252 and related description) a request for a component (*see e.g.*, p. 1, lines 19-21) having at least one specified attribute (*see e.g.*, ref. num. 230 and related description), broadcasting the request (*see e.g.*, ref. num. 220 and related description) across the network (*see e.g.*, ref. num. 216 and related description), receiving (*see e.g.*, ref. num. 262 and related description) the request (*see e.g.*, ref. num. 220 and related description) at a service provider (*see e.g.*, ref. num. 212 and related description), comparing (*see e.g.*, ref. num. 264 and related description) at least one specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request with component attributes (*see e.g.*, specification p. 1, lines 19-21 and ref. num. 230 and related description) of the service provider (*see e.g.*, ref. num. 212 and related description), and communicating a response (*see e.g.*, ref. num. 240 and related description) to the requesting service consumer (*see e.g.*, ref. num. 214 and related description), wherein the response indicates a location of the requested component associated with the service provider.

As embodied in claim 12, a distributed computer networked system accesses a remote software component (*see e.g.*, specification p. 1, lines 19-21) comprising: at least one service consumer (*see e.g.*, ref. num. 214 and related description), at least one service provider (*see e.g.*, ref. num. 212 and related description), means (*see e.g.*, ref. num. 250 and 252 and related description) for generating a request (*see e.g.*, ref. num. 220 and related description) at a service consumer (*see e.g.*, ref. num. 214 and related description) for a component having a least one specified attribute (*see e.g.*, ref. num. 230 and related description), means for broadcasting the request (*see e.g.*, ref. num. 220 and related description) across the network (*see e.g.*, ref. num. 216 and related description), means (*see e.g.*, ref. num. 260 and 262 and related description) for receiving the request (*see e.g.*, ref. num. 220 and related description) at a service provider (*see e.g.*, ref. num. 212 and related description), means (260 and 264) for comparing the at least one

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specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request (*see e.g.*, ref. num. 220 and related description) with component attributes of the service provider (*see e.g.*, ref. num. 212 and related description), and means (*see e.g.*, ref. num. 260 and 266 and related description) for communicating a response (*see e.g.*, ref. num. 240 and related description) to the requesting service consumer (*see e.g.*, ref. num. 214 and related description), wherein the response indicates an identification of the requested component associated with the service provider.

As embodied in claim 20, a distributed computer networked system locates a remote software component (*see e.g.*, specification p. 1, lines 19-21). The system comprises at least one service consumer (*see e.g.*, ref. num. 214 and related description) and at least one service provider (*see e.g.*, ref. num. 212 and related description). The system further comprises a mechanism configured to generate a request (*see e.g.*, reference number 252 and related description) at a service consumer (*see e.g.*, ref. num. 214 and related description) for an identification of a component (*see e.g.*, p. 1, lines 19-21) having a least one specified attribute (*see e.g.*, ref. num. 230 and related description). The system further comprises a mechanism configured to broadcast the request across the network (*see e.g.*, reference number 220 and related description). The system further comprises a mechanism configured to receive the request (*see e.g.*, ref. num. 220 and related description) at a service provider (*see e.g.*, ref. num. 212 and related description). The system further comprises a mechanism configured to compare the at least one specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request (*see e.g.*, ref. num. 220 and related description) with component attributes of the service provider (*see e.g.*, ref. num. 212 and related description) to identify a matching component. Finally, the system further comprises a mechanism (*see e.g.*, ref. num. 260 and 266 and related

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description) configured to communicate a response (*see e.g.*, ref. num. 240 and related description) by the service provider to the requesting service consumer (*see e.g.*, ref. num. 214 and related description), wherein the response indicates an identification of the requested component associated with the service provider.

As embodied in claim 21, in a distributed computer networked system having at least one service consumer (*see e.g.*, ref. num. 214 and related description) and at least one service provider (*see e.g.*, ref. num. 212 and related description), a method locates remote software components by a service consumer comprising: generating (*see e.g.*, ref. num. 252 and related description) a request (*see e.g.*, ref. num. 220 and related description) for an identification of a component (*see e.g.*, specification p. 1, lines 19-21) having at least one specified attribute (*see e.g.*, ref. num. 230 and related description), broadcasting the request (*see e.g.*, ref. num. 220 and related description) across the network (*see e.g.*, ref. num. 216 and related description); receiving (*see e.g.*, ref. num. 262 and related description) the request (*see e.g.*, ref. num. 220 and related description) at each of a plurality of service providers (*see e.g.*, ref. num. 114, 126, 136, 212 and related description) on the network (*see e.g.*, ref. num. 216 and related description), comparing (*see e.g.*, ref. num. 264 and related description), at each of the plurality of service providers (*see e.g.*, ref. num. 114, 126, 136, 212 and related description), the at least one specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request (*see e.g.*, ref. num. 220 and related description) with component attributes of the service provider (*see e.g.*, ref. num. 212 and related description), and communicating, from each of the plurality of service providers (*see e.g.*, ref. num. 114, 126, 136, 212 and related description), a response (*see e.g.*, ref. num. 240 and related description) to the requesting service consumer (*see e.g.*, ref. num. 214 and related



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description), wherein the response indicates an identification of the requested component associated with the service provider.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Independent claims 1, 12, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al and Boyles.

## **VII. ARGUMENT**

### ***Fundamental Distinction of All Claims Over Cited References***

The Office Action has rejected all claims as allegedly anticipated by Utsumi. Applicant respectfully disagrees. The summary of the present application states:

The present invention is broadly directed to a system and method for accessing software components, interfaces, or resources in a distributed network environment. *A distinctive feature of the invention is its ability to locate such components, interfaces, or resources based upon certain specified attributes, and without having prior knowledge of the address or location of the component, interface, or resource.*

(*Emphasis added.*) This stated essence of Applicant's invention cannot be achieved in the system of Utsumi. This broadly stated objective or feature is achieved, in certain embodiments, by the broadcast (over a network) of a request for a component that has at least one attribute specified in the request. In addition to other features, every independent claim of the present application embodies at least the three features/concepts, which are underlined above. The rejections applied by the Office Action, however, have either blurred or ignored these features. For at least this reason, the rejections are misplaced and should be withdrawn. Further, the

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system disclosed in Utsumi relates to the reservation of a resource at the request of a user. The system of Utsumi, as described, requires a priori knowledge by the user of the resources of the system. In contrast, and as noted above, the presently-pending claims define systems and methods which have the “ability to locate such components, interfaces, or resources based upon certain specified attributes, and without having prior knowledge of the address or location of the component, interface, or resource.”

Further still, the system of Utsumi relates to the reservation of a resource at the request of the user. In contrast, the claimed invention relates to the identification of available components and not necessarily the reservation of the components. As an example, the specification describes a scenario in which a user specifies the component of a network printer having the attribute of color printing capability. In response to such a broadcasted request, the relevant network printers would reply to the request. The service consumer (e.g., user’s system) would then have an identification of the network printers capable of printing in color. At this point, however, none of the printers have been allocated to process a print job (e.g., these resources have not been reserved, but merely identified).

Another distinguishing feature of embodiments of the present application relate to the locating of resources (or components) on a network, without having *a priori* knowledge. Applicant previously amended independent claims 1, 20, and 21 to clarify such embodiments. Further, Applicant previously amended claims 1, 12, 20, and 21 to specify that the “response,” communicated from the service provider in response to the request from the service consumer, “indicates an [availability or location] of the requested component associated with the service provider.” In the system of Utsumi, the user actually schedules a resource. In order to perform this scheduling operation, the user must have *a priori* knowledge of the resource being

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scheduled. In contrast, the embodiment specified by claims 1, 12, 20 and 21 broadcasts a request (over a network) for an identification of components that embody a specified attribute. Then, in response to this broadcast request, one or more service providers communicate a response, which “indicates an [availability or location] of the requested component...” Thus, the claimed system and operation specified a structure/method for locating resources/components that embody certain specified attributes. Scheduling of these resources may be done later. Significant, with respect to these claims, the identification of (or locating) such components is quite different than the scheduling of the components (as is taught by Utsumi).

For at least these fundamental reasons, the application of Utsumi to the pending claims is misplaced and should be overturned by the Board.

Notwithstanding the foregoing global distinction that is applicable to all claims, independent claims 1, 12, and 21 will be individually discussed below.

***Combination of Utsumi and Boyles is Improper***

As a separate and independent basis for the patentability of all claims, Applicant respectfully submits that the combination of *Utsumi* and *Boyles* is improper and should be withdrawn.

The Office Action rejected all claims 1-21 as allegedly obvious over the combination of *Utsumi* and *Boyles*. In forming this rejection, the Office Action merely concluded that the combination of these two references would have been obvious “because both Utsumi and Boyles teach inventions regarding client devices requesting resources from servers [, and because] having the response indicating a location of the requested component would permit a target resource in a computer network to be dynamically located as taught by Boyles (Col. 2, lines 50-

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54).” (Office Action, page 4, second and third paragraphs). Applicant respectfully disagrees. Among other reasons for traversing this rejection, Applicant respectfully submits that this rejection falls far short of the legal requirements for forming rejections under 35 U.S.C. § 103(a).

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

“The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ...” Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.”

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a system or method for accessing a remote software component by a service consumer over a distributed computer networked system, as defined by the pending claims.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro

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Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The Office Action has failed to cite any apparent disadvantage of *Utsumi*, which would prompt the combination of select teachings of *Boyles* therewith. Further, the portion of *Boyles*, which the Office Action relied upon (col. 2, lines 50-54) could be used, using the Examiner’s rationale, to combine the teachings of *Boyles* with ANY reference for the purpose (as stated in *Boyles*) of “permitting a target resource in a computer network to be dynamically

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located in a series of operations which reduce network traffic while assuring that current resource information is available for sessions to be established.” Such a broad-sweeping application of any reference is simply contrary to the established Federal Circuit precedent for constructing proper rejections under 35 U.S.C. § 103(a).

For at least this separate and independent basis, the rejections of claims 1-21 should be withdrawn.

***Present Rejection is Inconsistent with Prior Admission by the Examiner***

As another initial matter, Applicant respectfully submits that the present rejection is inconsistent with a prior admission by the Examiner. In this regard, the Examiner admitted that “Utsumi has not explicitly taught broadcasting the request” (see Office Action mailed 12-21-2004, p. 2, last line). Indeed, the rejection set forth in that Office Action relied on multiple references to form the rejections under 35 U.S.C. § 103(a). Now, the present Office Action has rejected all claims under 35 U.S.C. § 102(e), alleging that Utsumi, in fact, explicitly teaches the claimed feature of “broadcasting the request across the network.”

The Patent Office has consistently held that admissions are binding throughout the entire prosecution of a patent application. Typically, such admissions are relied upon by the Patent Office when an Applicant fails to immediately and adequately traverse a finding of Official Notice by an Examiner. In such situations, Applicants are deemed to have admitted whatever finding the Examiner set forth in the Official Notice, and once these admissions are deemed to have been made, such an admission cannot later be taken back.

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Under the same authority of the Administrative Procedure Act (5 U.S.C. § 500 et seq.) which empowers the PTO to rely on such admissions, Applicants should equally be able to rely on admissions by the PTO.

In addition to this admission retraction, Applicant notes that the present application of Utsumi to the pending claims is different than the prior applications of Utsumi. For example, the first element of claim 1 calls for "generating a request for a component..." The present Office Action cites Col. 9, lines 51-57 of Utsumi as disclosing this feature. In contrast, the FINAL Office Action of December 21, 2004, cited Col. 2, lines 4-5 of Utsumi as allegedly disclosing this feature. Similarly, almost all other applications of Utsumi to the claimed features are now different than they have been applied previously.

For at least these reasons, Applicant respectfully submits that the present rejection (based on Utsumi) is improper, and for the same reasons that admissions by Applicants are binding throughout the prosecution of an application, the prior admissions by the Examiner should be binding upon the PTO as well.

Furthermore, in responding to the FINAL Office Action and then in an Appeal Brief, Applicant previously set forth significant substantive distinctions of the claimed invention over the cited teachings of the Utsumi reference. The present Office Action, however, has failed to respond to Applicants' remarks, or address any of Applicants' distinctions. Instead, the present Office Action has only repeated the rejections set forth in the previous non-Final Office Action. Therefore, Applicant assumes that the Examiner agrees with all previous distinctions set forth by the Applicants (this is unclear from the record created by the Examiner, in the Examiner's refusal to substantively respond to Applicant's previous remarks).

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***Claims 1-11 and 20***

Turning now to the rejected claims, the Office Action rejected independent claim 1 as allegedly obvious over the combination of *Utsumi* and *Boyles*. For at least the reasons set forth below, Applicant respectfully disagrees.

Independent claim 1 recites:

1. In a ***distributed computer networked system*** having at least one service consumer and at least one service provider, a method for locating a remote software component by a service consumer comprising:  
generating a request for a ***component having at least one specified attribute***;  
***broadcasting*** the request across the network;  
receiving the request at a service provider;  
***comparing at least one specified attribute of the received request with component attributes of the service provider***; and  
communicating a response to the requesting service consumer,  
***wherein the response indicates a location of the requested component associated with the service provider.***

(*Emphasis added.*) Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

In forming the rejection, the Office Action has cited disjoint and unrelated features of *Utsumi*, and in doing so has ignored features of the claim. For example, elements of claim 1 recite: “generating a request ...”, “broadcasting the request ...”, “receiving the request ...”, and “comparing ... the received request ...” As emphasized above, each of these elements is linked and interrelated to the surrounding elements. However, the Office Action has used very disparate teaching of the *Utsumi* patent to form its rejection. In this regard, the Office Action cited col. 9 as teaching the “generating a request...” feature, then jumped to col. 18 for allegedly teaching the “broadcasting the request ...” feature. Then, the Office Action jumped back to col. 11 as



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allegedly teaching the “receiving the request ...” feature, and col. 17 as allegedly teaching the “comparing ... the received request ...” feature. This alone reflects an apparent lack of applicability of the cited teachings of the Utsumi patent.

More significantly, claim 1 recites: “comparing at least one specified attribute of the received request with component attributes of the service provider.” The Office Action cites col. 17, lines 26-28 and column 9, lines 6-33 and 51-57 as teaching this feature. Applicant disagrees. In fact, these cited portions of Utsumi actually state:

Next, a flexible set-up mechanism will be explained. In the ASP, resources can be reserved in various forms to use resources efficiently or to make resource reservation which matches with a request from an application.

(Col. 17, lines 26-28).

FIG. 5 shows examples of resource reservation parameters as predetermined data necessary for the client I/F compatible with the Internet TV and Internet VoD. These resource reservation parameters are required for network resource reservation when receiving information concerning respective programs to be provided through the Internet TV and Internet VoD. For example, when a client terminal makes a connection with a server in the service providing side, the parameters are transmitted from the server side and stored as a client setting file 54A in the database 54 of the client terminal.

In the example of FIG. 5, set as resource reservation parameters are a service number for specifying the content of a service, a program title which can be provided as a service, a server address such as a broadcasting station address of Internet TV or Internet VoD (e.g., an IP address of a network layer), a port number which specifies a service in a server (e.g., a TCP/UDP port number of a transport layer), a transfer rate for specifying a band resource required on a network when providing a service, a read/write size with respect to a socket as a unit of data read/written from/into OS (operating system) by an application of a serve, a socket buffer size as the size of a buffer for a socket, maximum and minimum transfer sizes of data (in units of bytes) transferred on the network, a token packet size as one of parameters in a so-called token packet algorithm (e.g., the maximum data amount which can be outputted at once onto the network), and a multicast IP address and port number which are used for executing multicast providing.

...

Returning to FIG. 4, program titles among resource reservation parameters are displayed on the program selection buttons 101. Accordingly, a user (or client

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terminal) selects a button displaying a desired program title from the program selection buttons 101 and can then receives a service of video data and audio data corresponding to the selected program through the Internet TV or Internet VoD.

(Col. 9, lines 6-33 and lines 51-57)

As can be readily verified from even a cursory review of this cited portion of Utsumi, there is no proper teaching of the claimed “comparing at least one specified attribute of the received request with component attributes of the service provider.” For at least this reason, the rejection is misplaced and should be withdrawn.

As a separate and independent basis for the patentability of claim 1, Applicant has previously made certain clarifying amendments to this claim, which clearly define over the teachings of Utsumi. For example, the preamble was amended to clarify that the embodiment is a method for “locating” a remote software component. As described in the specification, embodiments of the invention relate to the detection or identification of equipment (or components) on a network that contain or embody certain specified attributes (e.g., printers that are capable of color printing). This is clearly different than the scheduling of Utsumi (which system of Utsumi requires a priori knowledge of the components on the network).

Further, the last element of claim 1 was previously amended to specify that the response “indicates a location of the requested component associated with the service provider.” The FINAL Office Action alleges that Boyles discloses this feature at Col. 7, line 64 – Col. 8, line 4 (and FIG. 4D). Applicant respectfully disagrees.

This cited portion of Boyles actually states:

If such nodes exist, the origin cache server node directs the LOCATE request to all such nodes simultaneously in operation 104 and waits for replies. If a response from one of the alternate cache server nodes indicates that the target resource exists but is not within the domain of any of the active cache

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server nodes, then operation 106 causes a verification request to be directed immediately (in operation 108) to the resource location identified in the reply.

As can be readily verified from even a cursory review of the cited portion of Boyles, there is no teaching of the claimed limitation of “the response [indicating] a location of the requested component associated with the service provider.” In fact, claim 1 is directed to the location of a software component at a service provider, whereas the cited portion of Boyles is concerned with a LOCATE operation, which Boyles specifically defines as being an operation in which a unit obtains information about a target (see Boyles, col. 2, lines 7-10). Simply stated, this LOCATE operation does not teach the claimed feature, particularly in the context of the claimed embodiment.

For at least the foregoing reasons, the rejection of claim 1 should be overturned. For at least the same reasons the rejections of claims 2-11, which depend from claim 1, should be overturned as well.

Independent claim 20 encompasses certain similar features, and for purposes of this appeal, should be allowed for at least the same reasons advanced above in connection with claim 1.

#### ***Claims 12-19***

The Office Action rejected independent claim 12 as allegedly obvious over the combination of *Utsumi* in view of *Boyles*. Claim 12 includes salient features of “means for generating a request ... for a component having at least one specified attribute”, “means for broadcasting the request across the network” and “means for comparing the at least one specified attribute of the received request with component attributes of the service provider.”

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On a broadly-applied substantive basis, certain features of claim 12 loosely correspond to features discussed above in connection with claim 1. Therefore, the rejection of claim 12 should be overturned for many of the same reasons discussed above in distinguishing claim 1.

In addition, the FINAL Office Action improperly interpreted claim 12 to “encompass the same scope of the invention as that of the claims 1...” (FINAL Office Action, p. 6, lines 10-12). Applicant disagrees. Claim 1 is a method claim and claim 12 is an apparatus claim. Further, the elements of claim 12 are set forth in means-plus-function form, and as such require a differing interpretation. To date, however, the Examiner has failed to properly construe (and therefore apply) the elements of claim 12. For this reason alone, the Examiner’s rejection should be reversed as legally improper.

Pursuant to 35 U.S.C. § 112(6), a claim element recited in means-plus-function format “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112, ¶ 6. The Federal Circuit has clearly endorsed this statutory mandate by holding that claims interpreted under 35 U.S.C. § 112, paragraph 6, are limited to the corresponding structure disclosed in the specification and its equivalents. *Kahn v. General Motors Corp.* 135 F.3d 1472, 45 U.S.P.Q.2d 1608 (Fed. Cir. 1998).

There should be no question but that the elements recited in claim 12 are to be construed pursuant to 35 U.S.C. § 112, paragraph 6. In *Greenberg v. Ethicon Endo-Surgical Inc.*, 91 F.3d 1580, 39 U.S.P.Q. 2d 1783 (Fed. Cir. 1996), the Federal Circuit stated that the use of “means for” language generally invokes 112(6). Indeed, only if means-plus-function claim elements recite sufficient structure to carry out the function are they taken out of the ambit of 35 U.S.C. §

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112, paragraph 6. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 41 U.S.P.Q.2d 1001 (Fed. Cir. 1996).

Indeed, the Federal Circuit reiterated in Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420, 44 U.S.P.Q.2d 1103 (Fed. Cir. 1998) that “the use of the word ‘means,’ which is part of the classic template for functional claim elements, gives rise to ‘a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses.” Ultimately, the Court in Sage construed the relevant claim elements under 35 U.S.C. § 112(6), because ‘means’ were recited, and the claim elements did not “explicitly recite[s] the structure, material, or acts needed to perform the [recited] functions. Sage at p. 1428. The Federal Circuit further acknowledged this presumption in Al-Site Corp. v. VSI International, Inc., 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Thus, claim elements expressed in “means” plus function format are construed in accordance with 35 U.S.C. § 112, paragraph 6, as set forth above, and as further described in In re Donaldson 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(*en banc*). The following elements of claim 12, therefore, are to be construed in accordance with the structure disclosed in the specification: “means for generating a request ... for a component having at least one specified attribute”, “means for broadcasting the request across the network” and “means for comparing the at least one specified attribute of the received request with component attributes of the service provider.” Applicant notes that, in In re Donaldson, The Board of Patent Appeals and Interferences advanced the legal proposition that “limitations appearing in the specification are *not* to be read into the claims of an application.” In re Donaldson at 1848. This argument, however, was rejected by the Federal Circuit, which held, as a matter of law, that “one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the

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corresponding structure ... described therein, and equivalents thereof. *In re Donaldson* at 1848.

Furthermore, the holding in *In re Donaldson* does not conflict with the principle that claims are to be given their broadest reasonable interpretation during prosecution. *In re Donaldson* at 1850.

To date, however, the Examiner has failed to so construe these claim elements. Therefore, the rejection of claim 12 (being identical to the rejection of claim 1) is based on faulty and legally improper claim interpretation. For at least that reason, the rejection of claim 12 should be overturned.

With regard to dependent claims 13-19, the rejections to those claims should be overturned insofar as they depend from claim 12, and the rejection of claim 12 should be overturned.

#### ***Claim 21***

Finally, the Office Action rejected independent claim 21 (paragraph 19) as allegedly obvious over the combination of *Utsumi* and *Gulati*. Claim 21 includes salient features of “generating a request for a component having at least one specified attribute”, “broadcasting the request across the network” and “comparing, at each of the plurality of service providers on the network, the at least one specified attribute of the received request with component attributes of the service provider.” These features were discussed in connection with the rejection of claim 1, and therefore the rejection of claim 21 should be overturned for at least the same reasons as claim 1.

In addition, claim 21 specifically provides that the “comparing” take place “at each of the plurality of service providers on the network,” and further defines the “communicating, from each of the plurality of service providers, a response to the requesting consumer.” These added

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features are not disclosed in *Utsumi*. In this regard, the requested resource (in the system of *Utsumi*) will be allocated by only one provider (not a plurality of providers). As such, *Utsumi* cannot be properly applied to claim 21, and the rejection of claim 21 should be overturned.

***Traversal of Official Notice and Rejections of claims 11 and 16***

The Office Action takes Official Notice “that Java is a common programming language that programmers use to implement many software modules.” Then, the Office Action seems to use this alleged fact to support the motivation that is required for the obviousness rejection of claims 11 and 16.

Applicant hereby traverses this rejection and the Official Notice. With regard to the Office Action’s declaration of Official Notice, Applicant traverses this because the Office Action has not clearly defined specifically what it is taking notice of. For example, the Office Action alleges (as fact) that Java is a “common” programming language. However, the Office Action has not defined what it means by common, and therefore, has failed to define the extent or scope of the Official Notice. Likewise, the Office Action takes Official Notice that “programmers use [Java] to implement many software routines” without defining what it means to “use” Java, what “implement” means, or to quantify “many.” For at least these reasons, the Official Notice is indefinite and incomplete, and is respectfully traversed.

Further, Applicant traverses the rejections of claims 11 and 16, as the Office Action seems to rely on its Official Notice that Java is a “common” programming language, to complete these rejections. In this regard, the Office Action seems to equate “commonality” with the legal standard for “obvious.” That is, the Office Action seems to state that if something is common, then it is obvious. Such a position is, however, contra to well established Federal Circuit

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precedent for rejections under 35 U.S.C. § 103, and Applicant traverses the rejections of claims 11 and 16 on this additional basis.

### **CONCLUSION**

Based upon the foregoing discussion, Applicants respectfully requests that the Examiner's final rejection of claims 1-21 be overturned by the Board, and that the application be allowed to issue as a patent with all pending claims 1-21.

As the fee for this Appeal Brief has already been authorized to be charged to Hewlett-Packard Company's deposit account 08-2025, no additional fee is believed to be due in connection with this substitute brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,



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### **VIII. CLAIMS - APPENDIX**

1. In a distributed computer networked system having at least one service consumer and at least one service provider, a method for locating a remote software component by a service consumer comprising:

generating a request for identification of a component having at least one specified attribute;

broadcasting the request across the network;

receiving the request at a service provider;

comparing at least one specified attribute of the received request with component attributes of the service provider to identify a matching component; and

communicating a response by the service provider to the requesting service consumer, wherein the response indicates a location of the requested component associated with the service provider.

2. The method as defined in claim 1, wherein software component is selected from the group consisting of: a service, a resource, an interface, and a program segment.

3. The method as defined in claim 1, wherein the step of generating a request includes formulating a service descriptor, the service descriptor being an object that specifies the at least one specified attribute.

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4. The method as defined in claim 1, wherein the step of broadcasting the request utilizes a multicast protocol for broadcasting the request across the network

5. The method as defined in claim 1, wherein the network is a local area network.

6. The method as defined in claim 1, wherein the network is a wide area network.

7. The method as defined in claim 1, wherein the step of communicating a response utilizes a unicast protocol.

8. The method as defined in claim 1, further including the step of formulating a response by the service provider, which response includes an identification of a network location of the service provider.

9. The method as defined in claim 8, further including the step of directly requesting the component from the service provider by the service consumer, in response to the response received by the service consumer.

10. The method as defined in claim 8, wherein the step of formulating a response further includes associating with the response code for interfacing with the requested component, without requiring a driver to be separately installed on the service consumer.

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11. The method as defined in claim 10, wherein the code for interfacing with the requested code is Java code in the form of a stub object.

12. A distributed computer networked system for accessing a remote software component comprising:

at least one service consumer;

at least one service provider;

means for generating a request at a service consumer for a component having a least one specified attribute;

means for broadcasting the request across the network;

means for receiving the request at a service provider;

means for comparing the at least one specified attribute of the received request with component attributes of the service provider; and

means for communicating a response to the requesting service consumer, wherein the response indicates an identification of the requested component associated with the service provider.

13. The system as defined in claim 12, further including means for generating the response.

14. The system as defined in claim 13, wherein the means for generating the response is configured to include within the response a mechanism for identifying a network location for the component.

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15. The system as defined in claim 13, wherein the means for generating the response is configured to include within the response a code segment that allows the service consumer that generated the request to interface with the component without having a separately installed driver on the service consumer.

16. The system as defined in claim 15, wherein the code segment includes Java code in the form of a stub object.

17. The system as defined in claim 13, wherein the means for broadcasting the request includes a multicast protocol.

18. The system as defined in claim 13, wherein the means for generating a request includes a service finder.

19. The system as defined in claim 13, further including means for consolidating responses and providing the consolidated responses to the service consumer

20. A distributed computer networked system for locating a remote software component comprising:

at least one service consumer;

at least one service provider;

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a mechanism configured to generate a request at a service consumer for an identification of a component having a least one specified attribute;

a mechanism configured to broadcast the request across the network;

a mechanism configured to receive the request at a service provider;

a mechanism configured to compare the at least one specified attribute of the received request with component attributes of the service provider to identify a matching component; and

a mechanism configured to communicate a response by the service provider to the requesting service consumer, wherein the response indicates an identification of the requested component associated with the service provider.

21. In a distributed computer networked system having at least one service consumer and at least one service provider, a method for locating ~~accessing~~ remote software components by a service consumer comprising:

generating a request for an identification of a component having at least one specified attribute;

broadcasting the request across the network;

receiving the request at each of a plurality of service providers on the network;

comparing, at each of the plurality of service providers, the at least one specified attribute of the received request with component attributes of the service provider to identify a matching component; and

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communicating, from each of the plurality of service providers, a response to the requesting service consumer, wherein the response indicates an identification of the requested component associated with the service provider.

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**IX. EVIDENCE - APPENDIX**

None.

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**X. RELATED PROCEEDINGS- APPENDIX**

None.

*C-1*